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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/637,117 | 08/08/2003 | Geon Ho Im | CU-3321 RJS/WWP | 3823 |
| 26530 | 7590 | 09/20/2004 | EXAMINER | |
| LADAS & PARRY LLP 224 SOUTH MICHIGAN AVENUE SUITE 1200 CHICAGO, IL 60604 | | | KLEBE, GERALD B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3618 | |

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/637,117 | Applicant(s) IM, GEON HO ST | |
| | Examiner Gerald B. Klebe | Art Unit 3618 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

GB Klebe
10 Sep 2004

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Abstract

1. The content of the Abstract is objected-to as not providing a statement of the technical aspects of the invention and referring, instead, to purported merits of the invention.

Applicant is reminded of the proper content of an abstract of the disclosure:

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

A revised Abstract is required in response to this office action. Refer MPEP § 608.01.

Drawings

2. The drawings are objected-to for the following informalities:

Each of the figure numbers are enclosed in square brackets; this is improper format for the figure numbers; the square brackets should be deleted.

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Figure 1 shows an superfluous figure number designation; this should be deleted.

Appropriate correction is required.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

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Specification

3. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are:

page 3, line 1: use of a graphical symbol as substitute for a word is improper; this improper usage can be found a number of times elsewhere in the specification;

page 3, line 21: use of the word "decomposed" in this context is awkward and confusing;

page 4, lines 4-13: the entire context of this passage is improper and confusing;

page 5: the phrase "[Composition of the Invention]" is improper format for the specification.

Other examples exist. Appropriate correction is required.

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claims Rejection(s) - 35 USC § 112, 2nd Para.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Some specific examples are:

Claim 1 in lines 5 and 13: use of a graphical symbol to represent a word is improper in the claim.

Claim 2 consists of multiple sentences; claims must form a single sentence in the English language.

Other examples exist. Appropriate correction is required.

Claims Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, as best understood by the examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 4709937).

a. Lin discloses a roller skate that is easy to attach and detach characterized by: **(re: claims 1 and 2)** a foot support (Fig 1, combination of items 1 and 2, forming a longitudinally adjustable portion (1) and a transversely adjustable portion (2)), where the left and right sidewalls (211, 221) are formed with transverse projections (21, 22) formed as a single unit with the sidewall and that conjoin at a centerline of the skate and which are formed with a plurality of holes (not separately numbered; taken as the elongated slots forming through-holes in 21 and 22) and having U-shaped grooves (not separately numbered) in the transverse direction of the skate

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that conjoin and fit into a lower part of the mating portion of the transverse projection of the respective other sidewall, and each sidewall having projections (212, 222) for rotatably supporting a wheel (41, 42) of the skate; and having bands (111; 121) and clips (not separately numbered; taken as the end-clips on each band 111 and 121 whereby the bands can be secured to each other to enclose and secure the user's foot to the skate) so that attachment and detachment at the shoe of the user is enabled, and wherein the conjoining parts are secured with bolts and nuts (not separately numbered, but seen in the figure 1) so that the two foot supports are conjoined; and (**re: claim 3**) wherein the skate has an additional edge support ("scrap") (122) at the rear of the foot support so that the user's shoe may not slide off the rear of the skate.

b. **Regarding the further limitation of the claim 1** wherein the bands and clips are attached at an upper part of the side wall(s) of the foot support, the bands and clips of Lin et al. are attached to the longitudinally adjustable portion (1) of the foot support rather than at upper parts of the sidewalls of the transversely adjustable portions (2) of the foot support. However, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skate of Lin et al. to have the bands and clips attached at the upper part of the transversely adjustable portions (sidewalls) of the foot support since it has been held that rearranging parts of an invention involves only routine skill. *In re Japikse*, 86 USPQ 70.

c. **Regarding the feature of claim 4** wherein an additional separate conjoining support plate ("scrap") mating with the bottom of the projections of the transversely adjustable sidewall portions for the purpose of preventing movement of the sidewall foot support as a whole, relative to the longitudinal axis of the skate, the examiner takes Official Notice that it is old and well-known in the wheeled skate manufacturing arts to incorporate separate plates structure to mate

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with other structural portions of the skate and secured with a nut and bolt to prevent mating parts from loosening in use and sliding relative to each other.

8. Claim 5, as best understood by the examiner, is rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 4709937) **as applied to claim 2** in view of Darrow (US 266978).

Darrow teaches a roller skate that is easy to attach and detach and having left and right sidewalls each rotatably supporting a respective side wheel of the skate and wherein the wheel support is formed as a single unit with a wheel protection support to protect the wheel.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the wheel support sidewall portions of the skate of Lin et al. to include a wheel protection support formed as a single unit with each of the left and right side sidewall portions in accordance with the teachings of Darrow in order to, say, provide a structurally stronger journal for the wheel axles.

Prior Art made of Record

9. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Finn, of Klammer et al., of Huang, and of Giradelli each show structures having features similar to the features of the inventive concept of the instant application.

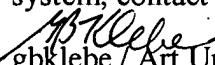
Conclusion

10. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-872-9306; Mon.-Fri., 8:00 AM - 4:30 PM ET, or to Supervisory Patent Examiner Christopher P. Ellis, Art Unit 3618, at 703-308-2560.

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Official correspondence should be sent to the following TC 3600 Official Rightfax numbers as follows: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service: 703-872-9325.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gbklebe / Art Unit 3618 / 10 September 2004



CHRISTOPHER P. ELLIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600